UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,327	01/12/2000	Yoshiyuki Takeuchi	DT-3300	5513

30377 7590 04/14/2004

DAVID TOREN, ESQ.
SIDLEY, AUSTIN, BROWN & WOOD, LLP
787 SEVENTH AVENUE
NEW YORK, NY 10019-6018

EXAMINER	
RIDLEY, BASIA ANNA	

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/481,327	Applicant(s) TAKEUCHI ET AL.	
	Examiner Basia Ridley	Art Unit 1764	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: _____.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

JERRY D. JOHNSON
PRIMARY EXAMINER
GROUP 1100

Continuation of 3. Applicant's reply has overcome the following rejection(s): some of the Specification rejections under 35 U.S.C. 112, firs paragraph and drawing objections.

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments are not persuasive.

Applicant argues that it would not have been obvious to substitute the furnace of Gravel with a rotary furnace because there is no express teaching to suggest such substitution. This is not found persuasive. The examiner has relied on equivalence of various furnaces as a rationale supporting an obviousness rejection. Said equivalence is recognized in the prior art (see Greve, C5/L3-16, which establishes equivalency of various furnaces). In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). It has been established that an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. I re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Applicant's statement that "Therefore, Greve, in which type of the furnace is not limited, teaches away from the glass fiber can be recovered as a valuable resource by using rotary kiln" is not clear. Further, the applicant has not presented any factual or testimonial evidence to establish why those of ordinary skill in the art would have expected that the equivalent furnaces of Greve would not work in th process of Gravel. In this regard, mere arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. In re Linder, 457 F.2d 506, 508-09, 173 USPQ 356, 358 (CCPA 1972); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).
Applicant's arguments regarding differences in process conditions disclosed by Greve and those of the instantly claimed invention, are no persuasive because Greve was not relied upon to disclose recited process condition. Examiner has relied upon Gravel to disclose said conditions, as set forth in the previous Office action.

Applicant's arguments that neither Babu et al. nor Hanson Jr. et al. teach rotary furnace are not persuasive because neither Babu et a nor Hanson Jr. et al. was relied upon to teach rotary furnace. The examiner has relied on equivalence, as established by Greve, as a rationale supporting substitution of a rotary furnace for a furnace of Gravel.

Applicant's statement "(...), it is respectfully submitted that Claim 1 rendered obvious by the combination of Gravel and Babu and is, therefore, patentably defines over said combination." is not clear. Further, the examiner notes that one can not show non-obviousness b attacking the references individually. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 882 (CCPA 1981). Greve establishes equivalency of various furnaces, as set forth above and in the previous Office action, therefore Gravel in combination with Greve and Babu et al. renders claim 1 obvious, as set forth in previous Office action.

The examiner notes that while amendment filed on 2 April 2004 overcomes some of the Specification rejections under 35 U.S.C. 112, first paragraph, the specification is still rejected under 35 U.S.C. 112, first paragraph .

35 U.S.C. 112, first paragraph requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

- unclear numbering of paragraphs - it is not clear why some paragraphs don't have any outline numbers (e.g. page 24, paragraph starting on line 6, etc.), while the other ones are numbered (e.g. page 36, etc.);

- unclear chemical formulas, e.g. formulas on page 7 or 9 have ∏ rather than arrows.

The applicant is reminded that the above instances are merely exemplary and that the disclosure should be carefully reviewed and revised to avoid unclear, inexact or verbose terms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Basia Ridley, whose telephone number is (571) 272-1453.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on (571 272-1444.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Technical Center 1700 General Information Telephone No. is (571) 272-1700. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

BR
April 9, 2004